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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,869	11/02/1999	STEVEN W. BROWN	APPL-P2840	1715

7590

03/25/2004

JONATHAN VELASCO
SIERRA PATENT GROUP
P O BOX 6149
STATELINE, NV 89449

EXAMINER

RAY, GOPAL C

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/432,869

Applicant(s)

BROWN, STEVEN W.

Examiner

Gopal C. Ray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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1. Claims 1-11 are presented for examination.
2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admitted prior art in view of US Patent 6,643,714 issued to Chrysanthakopoulos.

As per claim 1, applicant's admitted prior art teaches "creating a configuration ROM image for each link device; and presenting said configuration ROM image for each said link device" in Fig. 2, element 7 and page 5, lines 1-9 of the specification filed on 12/20/02.

Applicant's admitted prior art fails to teach "an individual configuration ROM image for each link device". However, the above feature was well known to one of ordinary skill in the art at the time the invention was made as evidenced by Chrysanthakopoulos. The reference of Chrysanthakopoulos teaches the feature in Fig. 3 and col. 1, lines 40-44. One of ordinary skill in the art at the time the invention was made would have realized that it is important to have an individual configuration ROM image for each link device for efficient and reliable operation of the computer system because that will enable to match the proper function and communication protocol of each device. The reference of Chrysanthakopoulos teaches the motivation in col. 1, lines 9-14. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the applicant's admitted prior art to

implement "an individual configuration ROM image for each link device" because that would make the applicant's admitted prior art system more efficient and reliable.

Furthermore, see MPEP 2144.04 V.C. and VI. B. for legal precedent as source of supporting rationale.

As per claim 2, applicant's admitted prior art teaches "said configuration ROM image includes an entry for a distinct identifier for a corresponding link device" in Fig. 2, elements 5a, 5b and page 4, lines 9-20.

As per claim 3, applicant's admitted prior art teaches the added feature in Fig. 2, element 7 and page 4, lines 9-20.

As per claim 4, applicant's admitted prior art teaches "Wherein said creating and presenting said configuration ROM image is carried out by transaction layer software" in Fig. 2, element 6 and page 5, lines 13-16.

As per claims 5 and 6, the claims recite apparatuses which parallel method claims 1 and 2 respectively. In teaching the construction and use of the device, the combination of applicant's admitted prior art and US Patent 6,643,714 issued to Chrysanthakopoulos teaches corresponding apparatuses.

As per claims 7 and 8, the claims are rejected for similar reasons as discussed in the rejection of claims 5 and 6 respectively.

As per claims 9-11, the claims are rejected for similar reasons as discussed in the rejection of claims 1-3 respectively with the exception of "a program storage device readable by a machine, tangibly embodying a program of instruction executable by the machine to perform the method". However, applicant's admitted prior art teaches the feature on page 4, lines 16-17. Furthermore, see MPEP 2144.04 V.C. and VI. B. for legal precedent as source of supporting rationale.

4. Applicant's arguments filed on 3/4/04 have been fully considered but they are not persuasive. Applicant argues that "... the admitted prior art of presenting a single configuration ROM image 7 for both link devices is fundamentally different from Examiner's characterization that applicant's admitted prior art teaches creating a configuration ROM image for each link device; and presenting said configuration ROM image for each said link device". However, applicant must be arguing from the spec. rather than the claims because the difference argued above is not apparent in the claims. The broadest interpretation of the claims read on the cited prior art. Applicant further argues that the secondary reference Chrysanthakopoulos discusses nodes, not link devices. However, the secondary reference Chrysanthakopoulos is applied to show that it is known in the art to have an individual configuration ROM image for each device. Furthermore, see MPEP 2144.04 V.C. and VI. B. for legal precedent as source of supporting rationale.

Moreover, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It is within the skill of an ordinary person in the art at the time the invention was made to create an individual configuration ROM image for each link device rather than one configuration ROM image for all link devices. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (703) 305-9647. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The new fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [mark.rinehart@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a

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possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2100 receptionist whose telephone number is (703) 305-3900.

Gopal C. Ray
**GOPAL C. RAY
PRIMARY EXAMINER
GROUP 2100**